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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 2038-323	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number 10/764,589	Filed January 27, 2004
on _____		First Named Inventor Takaaki SHIMADA et al.	
Signature _____		Art Unit 3761	Examiner Melanie Jo Hand
Typed or printed name _____			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,310</u> <u>703-684-1111</u> Telephone number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ Date <u>March 19, 2008</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	:	EXPEDITED PROCEDURE
	:	:	Response under 37 CFR 1.116
Takaaki SHIMADA et al.	:	:	Confirmation No.: 8968
	:	:	
Serial No. 10/764,589	:	:	Group Art Unit: 3761
	:	:	
Filed: January 27, 2004	:	:	Examiner: Melanie Jo Hand
	:	:	

For: PANTS-TYPE DISPOSABLE WEARING ARTICLE

**SECOND PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria VA 22313-1450

Sir:

This paper is submitted in reply to the Office Action mailed *December 19, 2007*.

Appellants respectfully request review of the final rejections of claims **4-6, 11-16, and 18-22** as manifested in the Office Action. No amendments are being filed with this request.

This request is being filed with a second Notice of Appeal in compliance with *37 CFR 41.31*. No additional fee is required as the fee has been previously paid with the set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

**REMARKS**

Claims 4-6, 11-16, and 18-21 stand rejected under 35 U.S.C. §103(a) over Okuda et al. (JP 2001157690) in view of Hall et al. (US 2004/006323).

At the outset, the asserted combination of references does not teach or suggest all of Appellants' claim limitations. Claim 4 recites, *inter alia*:

“a plurality of leg-surrounding elastic members extending along said crotch lateral zones in the leg-surrounding directions, respectively, and being contractible in said leg-surrounding directions.” (Emphasis added).

The Examiner asserts that Okuda discloses the recited leg-surrounding elastic members, but acknowledges that Okuda fails to disclose wherein:

“said leg-surrounding elastic members are interposed between said first sheet and said second sheet.” (Emphasis added).

The Examiner asserts that Hall remedies the deficiencies of Okuda. Appellants respectfully disagree with both assertions. More specifically, Appellants submit that elastic members 61 do not disclose, teach, or suggest leg-surrounding elastic members, as recited in independent claims 4, 11, and 18.

Unlike Appellants' recited leg-surrounding elastic members, Okuda, as depicted in Fig. 1, appears to only disclose elastic members 61 prolonged in the longitudinal direction of a diaper 1. Appellants respectfully submit that as disclosed by Okuda, when the distal ends of the diaper are brought together as a formed diaper, elastic members 61 do not form leg-surround members. More specifically, in order to surround a leg, elastic members 61 must traverse the perimeter of the

curved portion, i.e., the leg surrounding portion, of diaper 1. Because elastic members 61 do not traverse the leg defining portion, elastic members 61 do not disclose, teach, or suggest leg-surrounding elastic members, as recited by Appellants.

The laminate 70, disclosed by Hall, similarly fails to suggest the leg-surrounding feature recited by Appellants. As depicted in Figs. 2 and 3, elastomeric composite 60 comprises elastic strands 64, composite 60 being sandwiched between facing sheets 70, 72 to form laminate 70 of the diaper depicted in Fig. 8. As illustrated in Fig. 8, laminate 70 is not configured as a leg-surrounding material and more specifically, strands 64 are not leg-surrounding members.

Appellants respectfully submit, therefore, that claim 1 is patentable at least due to the failure of Okuda and Hall to disclose, teach or motivate all claimed features.

Independent claims 11 and 18 are similar to claim 1 and are patentable at least based upon the argument presented above in regards to claim 1. Indeed, claims 11 and 18 are further distinguished from Okuda and Hall in that claims 11 and 18 further recite:

“a plurality of third elastic members extending along peripheral edges of said leg-holes,” (emphasis added).

Neither Okuda, nor Hall disclose, teaches, or suggests the above feature.

Claim 5, 6, 12-16, and 19-22 depend variously from these independent claims and are likewise patentable over the asserted combination of references art for at least their dependence on an allowable base claim, as well as for the additional features they recite. Accordingly, reversal of this rejection is respectfully requested.

Notwithstanding the above presented argument, Appellants respectfully submit that the applied art fails to present any apparent reason to combine references or modify prior art to create the Appellants' allegedly obvious claim elements.

For example, the Examiner alleged that Hall teaches a laminate 70 (Fig. 6) that can be used in the leg opening areas of Okuda. In the Examiner's combination of Okuda and Hall, one of the facing sheets 72/74 of Hall would necessarily be located between the Hall leg elastics 64 and the Okuda auxiliary elastic members 21 and prevent the Hall leg elastics 64 from being directly attached to the Okuda auxiliary elastic members 21 as presently claimed.

Appellants respectfully submit that the Examiner's obviousness rationale is improper because Hall does not teach that the whole laminate 70 can be included between component layers of a base sheet, as alleged by the Examiner. The reference only discloses that the elasticized part of laminate 70, i.e., composite 60 (Fig. 4), can be used in expandable areas of the diaper. (See paragraph [0049], last sentence.) Laminate 70, if combined with Okuda, could only include the composite 60 between the layers of the base sheet. (See paragraph [0065], last line). Thus, it would only have been obvious, if at all, to incorporate the Hall composite 60 (rather than the entire laminate 70) between the sheets 3 and 5 of Okuda. In such resulting structure, there is no disclosure or suggestion that the Hall elastic threads 64 would be free of direct attachment with the Okuda auxiliary elastic members 21.

Applicants respectfully submit, therefore, that the claims are patentable not only due to the failure of Okuda in view of Hall, to disclose, teach or motivate all recited features of the claims, but are also patentable based upon the improper combination of Okuda and Hall, wherein the asserted combination of references present no apparent reason to combine references or modify prior art to create the Appellants' allegedly obvious claim elements.

Withdrawal of the final rejections of claims 4-6, 11-16, and 18-22 in view of the arguments incorporated by reference in the Remarks section above is believed appropriate and therefore respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

**LOWE HAUPTMAN & BERNER, LLP**

A handwritten signature in black ink, appearing to read 'BJH', is written over the printed name of Benjamin J. Hauptman.

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